

REMARKS

Claim 14 has been amended. Therefore, claims 1, 2, 4-10, 12-31, 33-37 and 39 are pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Section 121 Restriction:

The Examiner presented a restriction requirement requiring election of one of the following three inventions as defined by the Examiner:

I. Claims 1-8, 9-14, and 26-29, drawn to an apparatus for use in transaction, comprising non-volatile memory containing a set of multiple identifiers associated with a same customer account... classified in class 705, subclass 75.

II. Claim 16, drawn to an apparatus for use in making transaction, including a processor operable to randomly or pseudo-randomly select one identifier from said set of multiple identifiers for use in any transaction, classified in class 705, subclass 65.

III. Claims 15, 17-25, 30-35, 36-37 and 39, drawn to a method comprising opening an account record in an agency computer system, wherein said agency is to provide the account, receiving a public key from the portable transaction device, receiving a transaction record comprising a digital signature from the portable transaction device, classified in class 705, subclass 67.

In a telephone discussion between the Examiner and Applicant's undersigned attorney on October 10, 2008, Applicant provisionally elected Invention I **with traverse**. The Examiner acknowledged such election in the present Office Action. Applicant hereby confirms election of Invention I (as defined by the Examiner) **with traverse**.

Applicant traverses the restriction requirement on the grounds that the Examiner has not stated a proper restriction requirement. The Examiner states that each of Inventions I-III are related to one another as "subcombinations disclosed as usable together in a single combination." However, none of Inventions I-III are *disclosed* as *subcombinations* usable together *in a single combination*. To the contrary, independent

claims from each of Inventions I-III are methods and apparatuses for performing a transaction. A proper restriction requirement under M.P.E.P. 806.05(d) requires that the subcombinations “do not overlap in scope”. However, while not having identical scope, independent claims from each of Inventions I-III have clear overlap in scope. For example, claim 1 (Invention I), claim 16 (Invention II), and claim 15 (Invention III) each recite an apparatus configured to select an identifier from a set of multiple identifier for use in a transaction.

The Examiner appears to have misunderstood the concept of subcombinations usable together in a single combination. For a proper restriction, subcombinations are separate and distinct non-overlapping components of a larger system (the combination). For example, a seat bracket and a gear mechanism are subcombinations of a bicycle (the combination). A seat bracket and a gear mechanism are separate and distinct components that do not overlap in scope (i.e., are mutually exclusive). While there are differences in scope between independent claims of Inventions I-III, independent claims from each of the groups also clearly overlap in scope and are thus not restrictable subcombinations. *See M.P.E.P. 806.05(d).*

Furthermore, according to M.P.E.P. 806.05(d), to state a proper restriction requirement for subcombinations usable together in a single combination, “[t]he Examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination.” Moreover, M.P.E.P. 806.05(d) also states that “the burden is on the Examiner” to make this showing. The Examiner appears to have misunderstood the requirement for a subcombination to have utility *other than in the disclosed combination*. The Examiner merely points to differences between the claims. However, by definition, subcombinations will always have different utility *with respect to one another* by their very nature of being separate and distinct non-overlapping components of a larger system (combination). The requirement of M.P.E.P. 806.05(d) is that a subcombination have a “utility other than in the disclosed combination.” **All the examples given by the Examiner clearly apply to the same overall combination as**

disclosed in the specification. Therefore, the Examiner has not stated a proper restriction requirement.

Another shortcoming of the Examiner's restriction requirement is in regard to the requirement of M.P.E.P. § 808 for the Examiner to also show "reasons why there would be a serious burden on the examiner if restriction is not required". In regard to this requirement, the Examiner stated in the Office Action of October 20, 2008 that the inventions "have acquired a separate status in the art as shown by their different classification." However, the Examiner's reliance of a different classification to show a separate status in the art is misplaced because the purported classifications are clearly inaccurate and not separate for the three claim groups. For example, the Examiner states that Invention I is classified as class 705, subclass 75, Invention II is classified as class 705, subclass 65, and that Invention III is classified as class 705, subclass 67. However, these classifications could both be applied to all of the claims, and are thus not separate for the three groups. According to the Manual of Classification, the definition of class 705, subclass 75 is for business processing using cryptography including secure transactions and transaction verification. However, neither the claims of group I, group II nor the claims of group III require "business processing using cryptography including secure transactions and transaction verification". Nor do they exclude such business processing. Thus, class 705, subclass 75 is not a truly separate classification for the claims of groups I, II and III.

As shown above, under an accurate classification, the Examiner has not established that separate classifications apply to the claim groups. Since the purported classifications are not very accurate and actually relate to all of the claims, the Examiner clearly cannot rely upon these flawed classifications to establish "a serious burden on the examiner if restriction is not required." *See* M.P.E.P. § 808. Since the Examiner's has failed to establish a "serious burden on the examiner if restriction is not required", Applicant asserts that the Examiner has not established all of the necessary elements of a *prima facie* restriction requirement as required by M.P.E.P. § 808. Therefore, the Examiner's restriction requirement must be withdrawn.

Section 112, Second Paragraph Rejection:

The Examiner rejected claim 14 under 35 U.S.C. § 112, second paragraph as indefinite. Applicant's traverse the Examiner's rejection. However, claim 14 has been amended for clarity to read "limiting the number of transactions performed during a given period of time in order to prevent rapid read-out of the identifiers." Applicant asserts that one of ordinary skill in the art would clearly understand the meaning of claim 14 as amended when read in light of Applicant's specification. Accordingly, Applicant requests removal of the § 112 rejection of claim 14.

Section 103(a) Rejection:

The Examiner rejected claims 1, 2, 5, 7-10, 13 and 26-29 under 35 U.S.C. § 103(a) as being unpatentable over Walker, et al. (U.S. Publication 2006/0218098) (hereinafter "Walker") in view of Pitroda (U.S. Publication 2005/0247777), claims 4 and 12 as being unpatentable over Walker in view of Pitroda and further in view of Ritter, et al. (U.S. Patent 6,934,689) (hereinafter "Ritter"), claim 6 as being unpatentable over Walker in view of Pitroda and further in view of Palomo, et al. (U.S. Publication 2003/0120527) (hereinafter "Palomo").

Claim 1

In regard to claim 1, the cited art fails to teach or suggest wherein the apparatus is operable to, receive bill details for a given transaction of said plurality of transactions from the terminal through the communications facility, generate a transaction record from the bill details, wherein the transaction record includes a particular identifier selected by the processor from said set of multiple identifiers, and transmit the transaction record to the terminal through the communications facility. The Examiner cites paragraphs [0089] and [0100] of Pitroda, none of which

(even when considered in combination with Walker) teach or suggest the specific limitations of Applicant's claim. In paragraph [0100], Pitroda discloses the following:

If the sales person is satisfied with the signature comparison, the sales person completes the transaction, and the CIU transmits completed details of the sales transaction to the point of sales computer, the UET card, and the American Express service. Those details include the date of the transaction, the amount, the name of the retail store or service (for the UET card and the American Express service records), the name of the customer (for the American Express and point of sales computers), etc. (emphasis added)

The "details" described by the cited art (on which the Examiner presumably relies to teach Applicant's claimed "transaction record") do not include "a particular identifier selected by the processor from said set of multiple identifiers" as recited in Applicant's claim. In fact, neither Pitroda nor Walker, considered singly or in combination, teach or suggest anything about generating a transaction record from the bill details, wherein the transaction record includes a particular identifier selected by the processor from said set of multiple identifiers, as recited in Applicant's claim. Since the cited art fails to teach or suggest generating such a transaction record, the cited art cannot teach an apparatus configured to transmit such a transaction record to the terminal through the communications facility, as recited in claim 1.

Furthermore, Applicant's assert the Examiner has not stated a proper reason as to why one of ordinary skill in the art would have combined the teachings of the cited references to create Applicant's invention as claimed. The Examiner asserts that it would have been obvious to modify Walker with the teachings of Pitroda "since the claimed invention is merely a combination of old and known elements, and in the combination each element would merely would [sic] have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable." The Examiner's reasoning is circular and conclusory. More specifically, the Examiner's assertion that "the claimed invention is merely a combination of old and known elements" is not supported by any **actual evidence of record** since Pitroda and Walker fail to teach or suggest all limitations of Applicant's claim, as described above.

Thus, for at least the reasons presented above, the rejection of claim 1 is unsupported by the teachings of cited art and removal thereof is respectfully requested. Similar remarks apply to claims 9 and 26.

Applicants also assert that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejection has been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time. Applicants reserve the right to present additional arguments.

CONCLUSION

Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-20500/RCK.

Respectfully submitted,

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